



Attorney Docket No. 005950-657 *HM*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Dennis J. O'Rear

Application No.: 09/966,298

Filing Date: September 27, 2001

Title: Lube Base Oils with Improved Stability

Group Art Unit: 1764

Examiner: Ellen M. McAvoy

Confirmation No.: 5063

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GROUP 1700

SECOND
INFORMATION DISCLOSURE STATEMENT
TRANSMITTAL LETTER

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Enclosed is a SECOND Information Disclosure Statement and accompanying form PTO-1449 for the above-identified patent application.

- No additional fee for submission of an IDS is required.
- The fee of \$180.00 (1806) as set forth in 37 C.F.R. § 1.17(p) is also enclosed.
- A statement under 37 C.F.R. § 1.97(e) is also enclosed.
- A statement under 37 C.F.R. § 1.97(e), and the fee of \$180.00 (1806) as set forth in 37 C.F.R. § 1.17(p) are also enclosed.
- Charge _____ to Deposit Account No. 02-4800 for the fee due.
- A check in the amount of _____ is enclosed for the fee due.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Date: May 9, 2003

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Patent
Attorney's Docket No. 005950-657

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In re Patent Application of)
Dennis J. O'Rear) Group Art Unit: 1764
Application No.: 09/966,298) Examiner: Ellen M. McAvoy
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For: Lube Base Oils with Improved Stability)

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THIRD INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure as set forth in 37 C.F.R. § 1.56, Applicant hereby submits the following information in conformance with 37 C.F.R. §§ 1.97 and 1.98. Pursuant to 37 C.F.R. § 1.98, a copy of each of the documents cited is enclosed.

The documents are being submitted after a first Office Action on the merits but prior to the closing of prosecution, therefore under 37 C.F.R. § 1.97(c), a statement is enclosed. The documents enclosed were cited in a United Kingdom Search Report dated March 26, 2003.

I, the undersigned, hereby state that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Information Disclosure Statement.

To assist the Examiner, the documents are listed on the attached form PTO-1449. It is respectfully requested that an Examiner initialed copy of this form be returned to the undersigned.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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conditioning article was described in a way which suggested that air permeability of a supporting web was an essential feature, while claim 1 did not refer to permeability. Upholding a finding that the claim was not supported by the description (see 14.151(e)), Whitford J observed (though not referring to s.125) "I am bound to say that in infringement proceedings it appears to me probable that in fact against a description of the type to which I have referred on its true construction the claims of the specification would properly only be read as being limited to an article suitable for conditioning fabrics comprising a flexible woven or non-woven air-permeable web".

14.117 In view of the differences in the scope of protection which may be attached to various categories of claim (eg directed to a product, process, apparatus or use), the wording of a claim should leave no doubt as to its category.

Invention defined by reference to intended use

14.118 A claim to an apparatus or material for a particular purpose is construed as a claim to any apparatus or material having the features specified which is suitable for that purpose (see 2.12-2.14). On the other hand, a claim to something "when used in" a particular process is regarded as protecting only the use of the invention in this way (see 2.15), while a claim to "the use of" a material is regarded as equivalent to a claim to a method of using the material (see 2.16).

14.119 A claim merely directed to "Apparatus for carrying out the method of according to claim X", or some such wording will not normally be clear in scope. The claim should clearly specify the essential features of the apparatus unless all the integers which would constitute such apparatus are clearly implicit in the method claimed, and all such apparatus would be novel and non-obvious.

14.120 The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention, or a feature thereof, by a result to be achieved should not be allowed. However, they may be allowed if the invention can only be defined in such terms and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error. In *No-Fume Ltd v Frank Pitchford Co Ltd*, 52 RPC 231, a claim to an ash receptacle for smokers in which the dimensions of certain parts were such that smoke from objects thrown into the receptacle did not emanate from the receptacle was allowed on the grounds that the invention could be realised by dimensions other than those disclosed, by experiments not involving inventive ingenuity. However, claims of this kind are generally undesirable and it should be noted that the *No-Fume* claim was allowed solely because the invention did not admit of precise definition independently of the result achieved. Any claim which includes a subordinate clause prefaced by words such as "so that" or "the arrangement being such that" requires special consideration from this point of view.

Chemical cases

14.121 Where the invention relates to a chemical compound it may be characterised in a claim in various ways, eg by its chemical formula, as a product of a process or, exceptionally, by its parameters. Characterisation of a chemical compound solely by its parameters should, as a general rule, be allowed only in those cases where the invention cannot be adequately defined in any other way, for example in the case of macromolecular chains. In such cases however only parameters usual in the art should be employed to characterise the compound, since use of unusual parameters may disguise lack of novelty (see 2.18-2.20 and 3.26-3.29.1).

14.122 Chemical "process" claims should define the starting material, the end product and also the means adopted for converting the one into the other (*British Celanese Ltd's Application*, 51 RPC 192). The definition of a process in the claims with reference to such "tools of the trade" as condensation, polymerisation, esterification and sulphonation, or even by the use of the term "reacting", is permissible provided the specification contains no reservations affecting the universality of the process.

14.123 The extent to which the ingredients of a composition need to be specified in order adequately to define the invention depends greatly on the subject-matter concerned. Thus a claim to "a pharmaceutical composition containing compound X together with a diluent or carrier" is allowable, X being a medically active compound which characterises the composition, and the diluent or carrier being any material suitable